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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,873	02/07/2005	Volker Stanjek	WAS0681PUSA	4401
22045	7590	01/22/2007		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER MOORE, MARGARET G	
			ART UNIT	PAPER NUMBER
			1712	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/523,873

Applicant(s)

STANJEK ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1712

1. Initially the Examiner would like to note that, while there are various copending applications drawn to compositions having the -Si-CH₂- linkage, the Examiner has opted not to make any obviousness-type double patenting rejections. The instant claims are drawn to a process which could have been a restrictable invention from claims drawn to a composition (since the compositions could have been used in a process different from that claimed). Note too that none of the compositions are identical to the one used in the claimed process.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-14, 17-21 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sakagami et al.

Sakagami et al. teach a coating composition in which a silane compound and a silylated vinyl resin are used in admixture. See for instance Component (a) on column 2, which meets the reactive diluent in claims 20 and 21. Particular attention is drawn to the silylated vinyl resin as found on column 5, lines 45 to 50. Note that R¹¹ is a 1 to 4 carbon atom alkylene group. See column 11, lines 12 and on, which teach a coating process.

Patentees specifically mention methylene as one of four selections. In view of this limited selection, the teachings in Sakagami et al. anticipate the composition used in the instant process. To this extent note the following excerpt from the MPEP:

Art Unit: 1712

In *In re Schauman*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978), claims to a specific compound were anticipated because the prior art taught a generic formula embracing a limited number of compounds closely related to each other in structure and the properties possessed by the compound class of the prior art was that disclosed for the claimed compound. The broad generic formula seemed to describe an infinite number of compounds but claim 1 was limited to a structure with only one variable substituent R. This substituent was limited to low alkyl radicals. One of ordinary skill in the art would at once envisage the subject matter within claim 1 of the reference.

With regard to the pencil hardness on one hand, note that a chemical composition and the properties associated therewith cannot be separated. Since patentees teach the same composition as found in the claims, it follows that the compositions will have having the same properties. On the other hand, note Table 1-1 which shows various examples falling within the claimed hardness range. While the vinyl polymer in these examples contains a propylene rather than a methylene group, one would expect the properties associated therewith to be comparable in view of the close chemical similarity and the fact that they are embraced by the same, (limited) genus.

For claims 13 and 14, note that the structure on column 5, line 50, meets for formula (7). For claims 17 to 19, please see column 6, line 15 and on.

5. Claims 11, 12, 17 to 19, 20, 22 and 24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 2000/35981, as interpreted by the English language equivalent Majolo et al..

Majolo et al. teach a silyl terminated polymer. As can be seen from the bottom of column 2 through column 3, this can be prepared from a polyurethane prepolymer that is subsequently reacted with a silane. Particular attention is directed to the silane on column 7, the end of line 12 through line 13. This meets the claimed $-X-CH_2-Si(OR)_3$ unit required in claim 11. See also the description on the general formula (II) on the bottom of column 6, in which A can be CH_2 . Column 9 teaches polyesterpolyol polymers having terminal silyl groups. See the reactive silane on line 59 which also meets the required formula (6) in claim 11. Column 17, line 53, teaches using these polymers as surface coatings, meeting the claimed process limitation. Since patentees show specific examples of silanes that will result in the prepolymer of claim 11 this anticipates the claimed process.

Art Unit: 1712

Regarding pencil hardness, again note that products of identical chemical composition can not have mutually exclusive properties. A composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicants claim are necessarily present. If applicants are of the position that the prior art does not, in fact, possess the same properties as the claimed composition, the claimed composition should be amended to distinguish itself from the prior art.

For claims 17 to 19, please see column 16, lines 20 to 25. For claim 20 please see column 14, line 12 which teaches the addition of silanes. For claim 22, please see column 13, lines 27 to 37. For claim 24, note that the silane compounds shown which result in (6) have ethoxy groups.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Majolo et al.

Patentees do not specifically show a silane having a methylene bonded -NCO group. Column 9 provides the general teaching of such silanes and discloses that Y can be -NCO while A can be CH₂. In this manner one having ordinary skill in the art would have found the use of such a silane in preparing the silyl functional polymers of Majolo et al. to have been obvious.

7. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


The prior art fails to teach or suggest such a coating composition having no solvent. Note that Sakagami et al. require an organic solvent and the composition of Majolo et al. is present as an aqueous dispersion.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
1/18/07